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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,658	12/29/2006	Rudolf Schnuckenburger	87305.1520	7603
36734 7590 08/29/2010 BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304				
EXAMINER				
MERLINO, ALYSON MARIE				
ART UNIT		PAPER NUMBER		
3673				
NOTIFICATION DATE		DELIVERY MODE		
08/20/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@bakerlaw.com

Office Action Summary

Application No.

10/574,658

Applicant(s)

SCHNEKENBURGER, RUDOLF

Examiner

ALYSON M. MERLINO

Art Unit

3673

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Interval Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. The examiner acknowledges applicant's cancellation of claims 1-20 and the addition of new claims 21-31 filed 4 June 2010.

Claim Objections

2. **Claims 25, 26, and 31 are objected to** because of the following informalities:
 - a. In regards to claim 25, lines 5-7, should read as follows: "an intumescent material arranged such that its change in form either changes or fixes the relative position of at least one adjustable element, to either bring the door opener to a predetermined position or keep the door opener in a predetermined position."
 - b. In regards to claim 26, line 1, the phrase "a predetermined position" should be changed to "the predetermined position."
 - c. In regards to claim 31, line 2, the phrase "an initial state" should be changed to "the initial state." Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claims 21, 22, 25, 26, 30, and 31 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. **In regards to claim 21**, it is unclear to which component of the device applicant considers as the anchor, since this terminology is not used in the specification. For

examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

6. **In regards to claim 22**, it is unclear which component can be fixed by the change of form of the intumescent material in the limitation "fixes the relative position." For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

7. **In regards to claim 25**, it is unclear how the door opener includes at least one of a locking apparatus and a release apparatus. Specifically, if one considers the pivot latch 11, the changeover switch 12, and the armature 13 as the apparatus, then these components function as both a locking apparatus and a release apparatus, not just a locking apparatus or a release apparatus. Furthermore, it is unclear to which component of the device applicant considers as the anchor, since this terminology is not used in the specification. Also, it is unclear to which component of the device applicant considers as the at least one adjustable element, since this terminology is not used in the specification. For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

8. **In regards to claim 26**, it is unclear how the at least one of the locking apparatus and the release apparatus includes only one of a locking position and a release position, when it is unclear how the door opener includes at least one of a locking apparatus and a release apparatus, and for example, it is unclear how the locking apparatus could include a release position. The relationship between the

predetermined position and the apparatus is unclear. For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

9. **In regards to claim 30**, it is unclear in light of the specification and drawings which component applicant considers as the "fixed element." The claim recites that the intumescent material is arranged on a housing wall at a fixed element, and it is clear from the drawings and specification that the housing wall is the fixed element, since another element that is fixed is not discussed in the specification. For examination purposes, the housing wall will be considered equivalent to the fixed element until further clarification from applicant.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 21-24 and 28-31 are rejected** under 35 U.S.C. 102(b) as being anticipated by Saino (US-5380053).

12. **In regards to claim 21**, Saino discloses an intumescent material 47 for an actuator (Figure 2) of a fire protection device (Col. 2, lines 34-40), wherein the intumescent material is in operative connection with at least one of an anchor 37, and the actuator is in operative connection with the door to open the door (apparent from Figure 2).

13. **In regards to claim 22**, Saino discloses a door opener comprising a fixing apparatus (Figure 2) includes at least two elements 29, 37, (wall of portion 53 between the indicators of reference characters 47 and 55, Figure 2) whose relative position to each other is adjustable (apparent from Figures 2 and 4 that the relative position component 29 is adjustable with respect to the wall and component 37), wherein the intumescent material is in operative connection with at least one of the elements (Figure 2) such that the intumescent material, through its change in form, changes in such a way that in the event of fire a predetermined state is reliably assumed (apparent that the state in Figure 4 occurs in the event of fire, Col. 4, lines 51-59).

14. **In regards to claim 23**, Saino discloses that the intumescent material, as a result of its change in form, is in operative connection with the at least two elements, which are adjustable relative to each other (apparent connection between the elements and the material in Figure 4 through the cooperation of the elements).

15. **In regards to claim 24**, Saino discloses that the at least two elements are adjustable relative to each other (apparent from Figures 2 and 4), with one element being adjustable (element 29) and the other element being fixed in position (element 37).

16. **In regards to claim 28**, Saino discloses that the intumescent material, when in an initial state (state shown in Figure 2), is arranged at a free end 35 of one of the at least two elements whose relative position to each other is adjustable (Figure 2).

17. **In regards to claim 29**, Saino discloses that the intumescent material, when in an initial state (state shown in Figure 2), is arranged within an apparatus housing 51, 53 for filling a cavity 52 in the door opener (apparent from Figure 4).

18. **In regards to claim 30**, Saino discloses that the intumescent material, when in the initial state, is arranged on a housing wall (wall between indicators of reference characters 47 and 55, Figure 2) acting as a fixed element of the at least two elements proximate to an adjustable element 29 of the at least two elements (apparent from Figures 2 and 4).

19. **In regards to claim 31**, Saino discloses that the intumescent material, when in the initial state, is arranged in a recess (recess near indicator of reference character 47, Figure 2) of the housing wall.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. **Claims 22 and 27 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Thomas (US-4867496) in view of Saino (US-5380053).

22. **In regards to claim 22**, Thomas discloses a door opener (Figure 2) comprising a fixing apparatus including at least two elements 2, 12 whose relative position to each other is adjustable (apparent from Figure 7), wherein a material 44 is in operative connection with at least one of the elements (apparent from Figures 5 and 8) such that

the material, through its change of form, fixes the relative position of element 2 in the vent of fire so that a predetermined state is maintained (Col. 5, lines 21-28). Thomas fails to disclose that the material is an intumescent material. Saino teaches the use of an intumescent material 47 within a latching device. Since replacing the material that expands as a result of heat, disclosed by Thomas, with an intumescent material also expands would still allow the latch position to be fixed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the material disclosed by Thomas with an intumescent material since both materials expand when subjected to heat.

23. **In regards to claim 25**, Thomas discloses a door opener (Figure 2) including a locking/release apparatus (apparent from Figure 4), at least one anchor 12 and latch bolt 2 which are pivotally adjustable relative to each other (apparent from Figures 4-8), and a material 44 arranged such that its change in form fixes the relative position of the latch bolt to keep the door opening in a predetermined position (Col. 5, lines 21-28). Thomas fails to disclose that the material is an intumescent material. Saino teaches the use of an intumescent material 47 within a latching device. Since replacing the material that expands as a result of heat, disclosed by Thomas, with an intumescent material also expands would still allow the latch position to be fixed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the material disclosed by Thomas with an intumescent material since both materials expand when subjected to heat.

24. **In regards to claim 26**, Thomas discloses that the predetermined position of the locking/release apparatus is a locked position (apparent from Figure 5).

25. **In regards to claim 27**, Thomas discloses that the material, when in an initial state, is arranged at a fulcrum (near fulcrum with pin on which spring 32 is located, Figure 5) of element 2.

Response to Arguments

26. Applicant's arguments with respect to claims 21-31 have been considered but are moot in view of the new ground(s) of rejection.

27. The examiner appreciates applicant's amendments to Figure 2, and therefore, the drawing objection set forth in the previous office action is withdrawn.

28. Since claims 1-20 were cancelled, the drawing objections, claim objections, and rejections under 35 U.S.C. 112 and 101 are withdrawn.

Conclusion

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALYSON M. MERLINO whose telephone number is (571)272-2219. The examiner can normally be reached on Monday through Friday, 7:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on (571) 272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter M. Cuomo/
Supervisory Patent Examiner, Art Unit 3673

AM
August 13, 2010